



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Applicant : Sean T. O'Mara  
Application No. : 10/086,940  
Filed : March 1, 2002  
For : INTUBATION DEVICE AND METHOD

Examiner : Annette Fredricka Dixon  
Art Unit : 3771  
Docket No. : 920070.417  
Date : April 30, 2007

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO ADVISORY ACTION**

Commissioner for Patents:

In response to the Office Action mailed December 28, 2006 and the Advisory Action dated March 5, 2007, please extend the period of time for response one month, to expire on April 28, 2007 (Saturday). Enclosed are a Petition for an Extension of Time and the requisite fee. Applicant respectfully submits the following remarks.

Claims 66-71 and 73-78 are pending and were rejected. The Examiner rejected claims 66, 67, 71, 73, 74 and 78 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,820,614, issued to Bonutti. The Examiner rejected claims 68-70 and 75-77 under 35 U.S.C. § 103(a) as obvious over Bonutti in view of U.S. Patent No. 5,607,386 issued to Flam. Applicant respectfully traverses the Examiner's rejections.

Applicant previously submitted, on September 27, 2006, a declaration under 37 CFR 1.131 establishing that Bonutti is not a prior art reference under Section 102(e) or Section 103(a). Under Section 1.131, an Applicant can overcome a prior art reference by showing either (i) conception prior to the effective date and due diligence between just prior to the effective date

of the reference and the date of actual or constructive reduction to practice, or (ii) actual reduction to practice prior to the effective date of the reference. Applicant chose at that time to establish conception prior to the effective date coupled with due diligence.

In an Office Action dated December 28, 2006, the Examiner contended the declaration was ineffective to overcome Bonutti because the declaration failed to establish a date of conception. The Examiner also contended a statement in a supporting document constituted an admission that there was no prior conception and no diligence. In a response filed on February 7, 2007, Applicant noted that a date of conception need not be established; Applicant need only show that conception occurred prior to the effective date of the reference. Applicant also noted that the alleged "admission" was not pertinent to whether conception occurred prior to the effective date or to whether Applicant had acted with due diligence.

On March 5, 2007, the Examiner issued an Advisory Action. In the Advisory Action, the Examiner withdrew the assertion that the declaration was ineffective because it failed to establish a date of conception prior to the effective date of the reference and the assertion that the supporting document constituted an admission regarding due diligence. The Examiner contends in the Advisory Action that the declaration is ineffective because it in fact fails to establish due diligence. Applicant respectfully submits that the finality of the Office Action mailed December 28, 2006, should be withdrawn because the Examiner has provided a new basis for rejecting the declaration. Applicant also notes that the detail of the Office Action mailed December 28, 2006, fails to indicate the Office Action is a final Office Action.

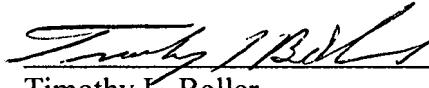
In any event, Applicant is submitting with this response a Supplemental Declaration of the Applicant establishing Applicant's actual reduction to practice prior to the effective date of the reference, as well as supporting documents and a supporting Declaration from a witness. In response to the Examiner's Advisory Action, (and as would be expected where the Examiner requested more information regarding dates), Applicant reviewed his records regarding the invention in more detail, and Applicant's memory was refreshed. Specifically, and as set forth in the Supplemental Declaration, Applicant built a working model and practiced the invention prior to the effective date of the reference. Actual reduction to

practice prior to the effective date of the reference renders any due diligence inquiry moot. See 37 CFR 1.131(b) and MPEP 715.07 (II).

Claims 67-71 depend from claim 66 and claims 74-78 depend from claim 73. The Examiner does not contend that Flam teaches, suggests or motivates the limitations of claims 66 and 73. Accordingly, claims 67-71 and 74-78 are allowable at least by virtue of their dependencies.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,  
SEED Intellectual Property Law Group PLLC

  
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Enclosures:

Declaration Under 37 CFR 1.131

Witness Declaration of Brian O'Mara Under 37 CFR 1.131

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